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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,432	07/30/2001	Rita Koester	H-3540-PCT/U	4209

23657 7590 01/26/2007

COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

EXAMINER

OGDEN JR, NECHOLUS

ART UNIT	PAPER NUMBER
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1751

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/831,432

Applicant(s)

KOESTER ET AL.

Examiner

Necholus Ogden

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-02-06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 14, 18 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The aforementioned claims state the phrase "anionic surfactant free" which does not appear to be supported by the original specification. Clarification and/or correction are required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14, 18 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The aforementioned claims state that the claims have a "narrow" homolog distribution. The examiner contends that this terminology is indefinite because the specification does not adequately define what "narrow" encompasses. The artisan of ordinary skill would be unable to determine the metes or bounds of the invention.

Art Unit: 1751

1. Claims 14-17, 25-28, 31, 33-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 05-202382.

JP '382 disclose a detergent composition useful for dish washers comprising 1-10% by weight of a nonionic surfactant of formula I which is an alkoxylated carboxylic ester; 1-40% by weight of builder such as citrates, polycarboxylic acid copolymers (see abstract).

As this reference teaches all of the instantly required it is considered anticipatory.

2. Claims 18-19, 24, 29-30 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP (05-202382) in view of Haerer et al (5,602,093).

JP '382 is relied upon as set forth above. JP '382 lacks the inclusion of an additional nonionic surfactant such as alkyl polyglucoside and alkyl polyglycol ethers.

Haerer et al '093 disclose a rinse aid for dishwashing machines comprising alkyl polyglycoside and alkyl polyglycol ethers (see abstract and col. 2, lines 24-34).

It would have been obvious to one of ordinary skill in the dishwashing art to include the alkyl polyglycoside and/or alkyl polyglycol ether surfactants of Haerer et al '093 because both prior art references teach the use of surfactants for automatic dishwashing and Haerer et al '093 teach that the aforementioned surfactants ecologically and toxicologically satisfactory and are equivalent in performance properties to commercial rinse aids and do not have any disadvantages (col. 2, lines 15-20). Moreover, "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third

Art Unit: 1751

composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

3. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP (05-202382) in view of Lewis (5,612,305).

JP '382 is relied upon as set forth above. JP '382 lacks the inclusion of applicant's specific alkyl polyglycol ether.

Lewis discloses a mixed surfactant system for low foam applications such as machine dishwashing wherein said surfactants include fatty alcohol polyalkylene glycol ethers wherein the alkylene unit consist of propylene groups (abstract; see formula III, col. 4, lines 15-25 and col. 5, line 5-col. 6, line 9).

It would have been obvious to one of ordinary skill in the art to include the specific polyglycol ethers of Lewis to the compositions of JP '382 because each reference is specific to auto dishwashing and Lewis teaches that said nonionic polyglycol ethers maintain low foam and defaming performance needed for automatic dishwashing and significantly reduces cost of other surfactants which form the major functional component(s) of the products used in these applications (col.4, lines 47-53).

Moreover, "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Art Unit: 1751

4. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP (05-202382) in view of Kwetkat et al (6,156,721).

JP '382 is relied upon as set forth above. JP '382 lacks the inclusion of an additional nonionic surfactants hydroxyl mixed ether and/or N-alkyl glucamides.

Kwetkat et al disclose a cleansing composition useful for automatic dishwashing machines comprising 0.1 to 70% by weight of surfactant such as hydroxyl mixed ethers and N-methyl alkylglucamides (col. 9, lines 1-5; and col. 10, line 1-3).

It would have been obvious to one of ordinary skill in the dishwashing art to include the mixed ethers and alkylglucamides because both prior art references teach the use of surfactants for automatic dishwashing. Moreover, "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

1. Claims 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hees et al (5,753,606) in view of Haerer et al (5,759,987).

Hees et al disclose a low foaming cleaning composition for hard surfaces comprising 0.1 to 50% by weight of an alkyl polyglycoside (col. 2, lines 13-27); fatty acid alkyl ester alkoxylates of formula (II) (col. 2, line 59-col. 3, line 24); and additional surfactants such as nonionic alkyl polyglycol ethers, fatty acid polyglycol ethers and

Art Unit: 1751

mixtures thereof (col. 3, lines 47-55) and further an auxiliary agent such as citric acid, polyacrylates and butylenes glycol (col. 4, lines 10-21). Note, see example 11.

Hees et al disclose all of the instantly required except applicant's additional N-alkyl glucamide nonionic surfactant.

Haerer et al disclose a hard surface cleaning composition comprising mixed ethers, glycol ethers and further nonionic surfactants such as alkyl polyglycoside and/or fatty acid N-alkyl glucamide surfactants (col. 2, line 5-col. 3, line 5).

It would have been obvious to one of ordinary skill in the art to include the N-alkyl glucamide type nonionic surfactant of Haerer et al to the compositions of Hees et al because Hees et al invite the inclusion of nonionic surfactants such as alkyl polyglycosides and Haerer et al suggest the alkyl polyglycosides and N-alkyl glucamides are functional equivalent nonionic surfactants for hard surface cleaning compositions and an additional nonionic surfactant such as N-alkyl glucamides would aid at reducing the foaming as required by the teaching of Hees et al. Therefore, absent a showing to the contrary, one of ordinary skill in the art would expect synergistic and/or beneficial results by including a N-alkyl glucamide nonionic surfactant in the compositions of Hees et al.

Claims 31-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8; 1-12; 1-11 and 25; and 1-14 of U.S. Patent No. 6602838; 6384009; 6683035; and 6660706; respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in subject matter pertaining to alkoxylated carboxylic acid esters

Art Unit: 1751

with hydroxyl mixed ethers or alkyl polyglycoside or polyglycol ethers or N-alkylglucamides.

Response to Arguments

2. Applicant's arguments filed 11-02-2006 have been fully considered but they are not persuasive.

Applicant argues that JP '382 does not disclose a "narrow" homolog distribution in an anionic surfactant free composition.

The examiner contends that applicant has not adequately defined what "narrow" encompasses and moreover, it appears that applicant's disclosure does not have support for the anionic surfactant free limitation.

Applicant argues that Haerer et al do not disclose any alkoxyated fatty acid esters.

The examiner contends that Haerer et al is only relied upon to show the inclusion of alkyl polyglycosides and alkyl polyglycol ethers in dishwashing compositions.

Applicant argues that Lewis cannot be combined with JP '382 without under experimentation.

The examiner contends that both reference are analogous and the alkyl polyglycol ether of Lewis is well known additive in auto dishwashing as suggested by Lewis in (col. 4, lines 47-53). Therefore, absent a showing to the contrary the references are combinable for their intended purpose.

Applicant argues that JP '382 and Kwetkat et al neither teach or suggest the claimed invention and therefore are untenable.

The examiner contends that the arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.").

Applicant argues that Hees requires anionic surfactants, which are excluded by the claimed invention.

Again, the examiner contends that it appears that applicant does not have literal support for said insertion. Therefore, the rejection is maintained.

Applicant argues that Haerer et al do not disclose any alkoxylated fatty acid esters.

The examiner contends that Haerer et al is only relied upon to show the inclusion of N-alkyl glucamides in dishwashing compositions.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 1751

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-T, Th-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Necholus Ogden
Primary Examiner
Art Unit 1751

No
1-21-2007